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09/872,914	06/01/2001	Ferdinand Schermel		4663

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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT PAPER NUMBER

3727

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/872,914 Examiner Stephen J. Castellano	Applicant(s) SCHERMEL, FERDINAND
	Art Unit 3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-7 and 9-23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1,3-7 and 9-23 is/are rejected.
 7) Claim(s) 1, 3-7, 9, 10, 22 and 23 is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 6/1/01 and 4/24/02 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.	6) <input type="checkbox"/> Other: ____.

Applicant submitted a second request for supervisory review filed June 27, 2003 as paper No. 25, which has been responded to by the Office letter mailed August 8, 2003 as paper No. 27.

Please refer to this Office letter for a response to remarks pertaining to the issues raised in the second request for supervisory review, these issues are restriction, new matter, priority, incorporation by reference, etc.] Claims 2 and 8 have been canceled. An action on the merits of claims 1-3-7 and 9-23 follows:

keep → ***Manner of Making Amendments***

Applicant must double space the lines of any text in an amendment whether the text is in the written specification, the claims or an abstract. Also, applicant must use an appropriately sized lettering such as 12 point or larger as the size used is too small to decipher punctuation when a facsimile copy is transmitted. Also, applicant should submit amendments in accordance with 37 CFR 1.121.

keep → ***Specification***

The use of the trademark RUBBERMAID has been noted in this application. It should be capitalized wherever it appears (capitalize every letter) and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The examiner suggests that appropriate generic terminology for the term RUBBERMAID could be "a plastic trash receptacle."

Drawing Objections

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 24, 2002 as a portion of amendment A filed on April 24, 2002 have been disapproved because they introduce **new matter** into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of five containers attached together as shown in Fig. 1. Further reasoning is given in the Office letter mailed August 8, 2003 as paper No. 27, in paragraph 5, proposed Fig. 1 shows "a specific arrangement of the containers, specific connections between containers, specific sizes of the containers, a specific number of containers, etc." These additional details which are shown in Fig. 1 are new matter.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable container as claimed in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3-6 . . .
In addition, all of the limitations of claims 3-7, 9, 10, 22 and 23 must also be shown in the same figure or corresponding figures.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

1, 3-6, 9, 10, 22, 24-26 ***Claim Objections***

Claims 1, 3-7, 9, 10, 22 and 23 are objected to because of the following informalities:

Claim 1 recites structure pertaining to a modular wheeled container system comprising a wheeled container, a first attachable container which rest on top of the wheeled container and a second attachable container which rest on top of the first attachable container which has not been shown in the drawings.

Appropriate correction is required. Appropriate correction may include the cancellation of the claim(s) or the removal of the objectionable portion of the claim(s). Do not submit new matter.

112 Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7, 9, 10, 17 and 21-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

[For claims 1, 3-7, 9, 10, 22 and 23,] the specification as originally filed doesn't contain support for a modular wheeled container system comprising a wheeled container, a first attachable container which rests on top of said wheeled container and a second attachable

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container which rests on top of said first attachable container. Also, the base perimeter greater than 55 inches is not supported by the original specification. **This is a new matter rejection.**

For claim 17, the specification as originally filed doesn't contain support for the six container arrangement having two wheeled containers, two attachable containers, a recycle container and a RUBBERMAID refuse container. In addition, the original specification doesn't support the attachment of an attachable container to a receptacle body of a wheeled container and an attachment of a recycle container to the receptacle body of the RUBBERMAID refuse container. **This is a new matter rejection.**

For claim 21, the specification as originally filed doesn't contain support for the six container arrangement having a container, a second container, a wheeled container, an attachable container, a recycle container and a RUBBERMAID refuse container. In addition, the original specification doesn't support the attachment of an attachable container to a receptacle body of a wheeled container and an attachment of a recycle container to the receptacle body of the RUBBERMAID refuse container. **This is a new matter rejection.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1, 3-6 . . .

Claims 1-3-7, 9-10 and 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it contains an optional limitation, "an optional second attachable container." The metes and bounds of the claim, that is, the scope of the claim can not

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be determined since it can't be determined if the second attachable container is part of the claim or not.

Claim 1 contains the limitation "the base perimeter" in lines 26 and 27. There is no ^a *I + can't be determined*
whether applicant is introducing this term or referring to previous recitation of the base perimeter.
Therefore, Claim 1 is confusing.

Claim 1 is indefinite because it contains "wherein and whereby" clauses (see lines 25 and 44-45). The words "wherein" and "whereby" have very different meanings in claim interpretation, as "wherein" clauses define a positive recitation of structure and "whereby" clauses define a non-positive recitation of the intended use of the invention. It can't be determined whether applicant is positively claiming structure or whether applicant is claiming the intended use of the modular wheeled container system.

Claims 7, 17, 21 and 23 refer to U.S. patent 4,691,840 to Ferbrache. The specific limitations found or described in Ferbrache must be inserted into the respective claim. Reference to a patent should never appear in a claim since the metes and bounds of the claim can't be determined. Claims 7, 17, 21 and 23 are indefinite.

Claims 7, 17, 21 and 23 contain the trademark/trade name RUBBERMAID. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is

used to identify/describe a plastic trash receptacle and, accordingly, the identification/description is indefinite. Claims 7, 17, 21 and 23 are indefinite.

Claim 12 is indefinite because the phrase “at least one said attachable containers” is not understood because it can’t be determined if applicant is referring back to the “at least one attachable container” of claim 11 or if applicant means to claim second or different containers different from the “at least one attachable container” of claim 11. Claiming “said at least one attachable container” would refer back to the attachable container of claim 11 but would make the claim indefinite because the attachable container would be stacked upon itself an impossible configuration. Claiming a different container by wording such as “a second attachable container” would make the claim more definite. Also, it is not clear why applicant uses the word “containers” instead of the singular version of “container.” The singular form is typically used when applicant claims at least one of a certain element. Such language is broadly interpreted to include one but doesn’t preclude the existence of more than one. When applicant desires to claim more than one or at least two or more of an element, the plural version of the word is typically used. “At least one said attachable containers” has been broadly interpreted as one second attachable container.

Claim 13 is indefinite because there is no antecedent basis for “said attached container,” both the “wheeled container” and the “at least one attachable container” have not been positively attached to each other or anything else. If applicant has meant the “attachable container,” then applicant needs to specify such by changing “attached” to “attachable.” It can’t be determined what is meant by “a second said wheeled container” since a second wheeled container should not

be referred to with the word "said" since "said" would refer to an existing second wheeled container. For similar reasoning, "a second said attached container" is indefinite.

Claims 14-20 are indefinite for similar reasoning and for reasons too numerous to mention in a brief Office action.

Claim 21 has two periods (the first on line 18, the second in the last line) and claim 21 is indefinite because it can't be determined whether the claim ends after the first period or the second period. Claims 7 and 17 are similarly indefinite. The periods in the remaining claims are barely visible (see previous comments about size of text and facsimile transmissions).

Art Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11 and 12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tiramani et al. ('559)(Tiramani 1) and Tiramani et al. ('847)(Tiramani 2).

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Ferbrache.

Ferbrache discloses a lid which is a second container resting on top of a first container, the handle of which both connects the second container and pulls the first container.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. (1531)

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and
(847)
Tiramani 2.
1

Each of the Tiramani references disclose the invention except for capacity of the container of 32 gallons and the base perimeter of 55 inches. Trash containers of 32 gallon capacity and 55 inch base perimeter are well known. It would have been obvious by engineering design choice to modify the size of the container to be 32 gallons in order to make the volume correspond to any quantity desired. No criticality has been assigned to the 32 gallon capacity. It would have been obvious by engineering design choice to modify the size of the base perimeter to be greater than 55 inch to have a base which is large enough in perimeter and area to be stable to be stacked upon without concern of the stack toppling. No criticality has been assigned to the 55 inch perimeter dimension.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Ferbrache.

The Tiramani references disclose the invention except for the specific handle/hitch of Ferbrache. Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

Claims 3-6, 9, 10, ~~13-16, 18-20~~ and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 and Tiramani 2 in view of Tolbert, Jr. (Tolbert).

The Tiramani references disclose the invention except for the additional wheeled container secured to an attached container. From the Tiramani references, it is well known that the combination of a wheeled container with an attachable container is old and well known. Tolbert teaches a plurality of side-by-side wheeled containers which are connected by their handles and roll together as a single entity in a tilted position. It would have been obvious to add another wheeled container with an attachable container by duplication of part and as taught by the Tiramani references and to connect the two wheeled containers by their handles as taught by Tolbert to provide a single entity which can be rolled in a tilted position as a single entity eliminating the need to make a trip with each container individually to transport all the containers to the same point from the same point.

24-26
Claims ~~7, 17, 21 and 23~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiramani 1 or Tiramani 2 in view of Tolbert as applied to claim 16 above, and further in view of Ferbrache.

The combination discloses the invention except for the specific handle of Ferbrache. Ferbrache teaches the handle of Ferbrache. It would have been obvious to modify the connection between the containers to be the handle of Ferbrache in order to provide a means for easy lifting by handle grasping, as well as, a latch in the same assembly to enhance the transportability and storage without adding parts.

Note that applicant states that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No.23. The claims are additionally obvious for this reason.

Response to Arguments Moot *this must change*

Applicant's arguments with respect to claims 1, 3-7 and 9-23 have been considered but are moot in view of the new ground(s) of rejection as the ground of rejection has changed for most claims as additional new matter was added to the claims and additional limitations have been added to the claims causing the examiner to modify the ground of rejection for that claim. Although claims 11 and 12 were not significantly changed, no arguments could be found that were specifically directed towards these two claims.

Applicant refers to a "t" patent in the first paragraph of his response. This reference is not understood.

Applicant requests that written specific details be provided regarding the issues in this case. The examiner has provided written specific details in this action and through out the prosecution of this application.

Applicant request a response to the facsimile letter received December 12, 2002 as paper No. 21. This letter was responded to by the letter mailed January 2, 2003 as paper No. 22. Applicant requests a response to the facsimile letter received June 27, 2003 as paper No. 25. This second letter was responded to by the letter mailed August 8, 2003 as paper No. 27.

Action is Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

S. Castellano
Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc
August 20, 2003